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Banner & Witcoff Ltd
1001 G Street N W
Washington, DC 20001-4597

EXAMINER

COLBERT, ELLA

ART UNIT	PAPER NUMBER
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3696

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/479,918	Applicant(s) KLATT ET AL.	
	Examiner Ella Colbert	Art Unit 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 17-30 are pending. Claims 17 and 25 have been amended in this communication filed 02/04/09 entered as Response After Non-Final Action and Request for Extension of Time.
2. The 35 USC 112, second paragraph rejection from the prior Office Action is hereby withdrawn.

Claim Objections

Claims 18-30 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Rule 1.75 (c) provides that "[0]ne or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. See also MPEP 608.01 (n), under the heading "III Infringement Test", second paragraph, wherein it states, "[t]he test for a proper dependent claim under the fourth paragraph of 35 USC 112 is whether the dependent claim includes every limitation of the claim from which it depends". See MPEP 608.01 (n).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 17-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Amended claims 17 and 25 recite "monitoring unit" but the Specification recites "monitoring function".

Claims 18-30 are also rejected because they depend from a rejected claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is vague and indefinite what Applicants' mean by a monitoring unit in claims 17 and 25. A monitoring unit is broad and varied and not defined by Applicants' specification or shown in the drawings.

Claims 18-30 are also rejected for their dependency on a rejected claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,563,999) Yaksich et al, hereafter Yaksich in view of (US 6,330,542) Sevcik et al, hereafter Sevcik.

With respect to claim 17, Yaksich teaches, a computer-implemented database monitoring unit located at a corporate facility, wherein the database monitoring unit detects changes to the corporate sales management system and, in response thereto, generates event data comprising information that describes the sales management event (col. 3, line 21-65 and col. 5, lines 30-61). Yaksich did not teach, a print processing facility, located at a geographic location different from the corporate location and coupled to the database monitoring unit over a network, wherein the print processing facility receives the event data, compares the event data to one or more predefined event rules that determine whether the printed product should be produced and, in response to a positive determination, automatically generates a print order for the printed product using information extracted from the event data. Sevcik discloses, a print processing facility, located at a geographic location different from the corporate location and coupled to the database monitoring unit over a network, wherein the print processing facility receives the event data, compares the event data to one or more predefined event rules that determine whether the printed product should be produced and, in response to a positive determination, automatically generates a print order for the printed product using information extracted from the event data (col. 1, lines 11-22, col. 3, lines 42-65, col. 6, lines 28-67, and col. 7, lines 1-2). It would have been obvious

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to one having ordinary skill in the art at the time the invention was made to have a print processing facility, located at a geographic location different from the corporate location and coupled to the database monitoring unit over a network, wherein the print processing facility receives the event data, compares the event data to one or more predefined event rules that determine whether the printed product should be produced and, in response to a positive determination, automatically generates a print order for the printed product using information extracted from the event data and to modify in Yaksich in view of Yaksich's manufacturing (printing) facility at a number of geographically remote locations and because such a modification would allow Yaksich to manage commercial printing and the inefficiencies that exist for both the buyers of commercial printing and the providers (see Sevcik - col. 1, lines 8-16).

With respect to claim 18, Yasich failed to disclose, The system of claim 17, wherein the print order comprises a procurement request that requires further approval by a corporate employee before the printed product is produced. Sevcik discloses, wherein the print order comprises a procurement request that requires further approval by a corporate employee before the printed product is produced (col. 1, lines 11-22, col. 3, lines 42-65 and col. 6, lines 28-67 –col. 7, line 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yaksich with the teachings of Sevcik because such a modification would allow Yaksich to understand the significance of receiving an immediate quote computed from various print providers, to consider the process involved, the transaction costs to the organization, and the steps that are apart of the process before the printed product is produced.

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With respect to claim 19. Yaksich discloses, The system of claim 17, wherein the procurement request is approved in a procurement system located at the corporate facility, and wherein the print processing facility transmits the procurement request to the procurement system for approval by the corporate employee (col. 8, lines 28-34, col. 9, line 1-col. 11, line 39 and col. 39, lines 39-42).

With respect to claim 20. Yaksich discloses, The system of claim 19, wherein the procurement system transmits the approval to the print processing facility which, in response thereto, produces the printed product (col. 39, lines 39-42).

With respect to claim 21. Yaksich discloses, The system of claim 17, wherein the print order comprises a print production request that is directly fulfilled by a print production system without further approvals (col. 40, line 65-col. 41, line 7).

With respect to claim 22, Yaksich discloses, wherein the print order comprises one or more print criteria that must be satisfied before the printed product is actually produced (col. 9 and 10, lines 25-67 and col. 11, lines 1-15).

With respect to claim 23, Yaksich and Sevcik did not teach, wherein the print processing facility notifies a corporate employee via e-mail of the print order, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the print processing facility notify a corporate employee via e-mail of the print order and to modify in Yaksich and Sevcik because such a modification would allow Yaksich and Sevcik to have the capability to have the delivery service send the image to the client for approval and the client can contact the system by electronic mail

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to confirm approval of the order (notification of the print order to the client (employee) via e-mail).

With respect to claim 24, Yaksich and Sevcik did not teach, wherein the corporate employee is specified in one of the predefined event rules, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the corporate employee specified in one of the predefined event rules and to modify in Yaksich and Sevcik because such a modification would allow Yaksich and Sevcik to have a confirmation from the client (corporate employee) as to the approval to execute the order in full according to the description in the client's order (predefined event rules).

With respect to claim 25. Yaksich failed to disclose, The system of claim 17, wherein the database monitoring unit and the print processing facility communicate over the Internet. Sevcik discloses, The system of claim 17, wherein the database monitoring unit and the print processing facility communicate over the Internet (col. 3, lines 21-65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yaksich to have an automated Internet system that features a series of graphical interfaces which represent various print providers and to have the optimal equipment for the project to be computed and for the project to be produced.

With respect to claim 26. Yaksich failed to disclose, The system of claim 17, wherein the print processing facility retrieves corporate-specific information in addition to the event data and uses the corporate-specific information to generate a print production request.

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Sevcik discloses, The system of claim 17, wherein the print processing facility retrieves corporate-specific information in addition to the event data and uses the corporate-specific information to generate a print production request.(col. 3, line 42-col. 4, line 11).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify in Yaksich with the teachings of Sevcik because such a modification would allow Yaksich to have a system that has a complete database of information for custom products which allows for search and retrieval of specific information and automatically generates quotes for custom products and ensures the project is produced on the equipment for that particular product.

Claims 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,563,999) Yaksich et al, hereafter Yaksich in view of (US 6,330,542) Sevcik et al, hereafter Sevcik and further in view of IPrint.com.

With respect to claim 27. Yaksich and Sevcik failed to disclose, The system of claim 26, wherein the corporate-specific information comprises a corporate logo that is not stored in the corporate sales management system. IPrint.com discloses, The system of claim 26, wherein the corporate-specific information comprises a corporate logo that is not stored in the corporate sales management system (Pg. 7, para. 3, Pg. 8, para. 2 and Pg. 9, para. 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify in Yaksich with the teachings of IPrint. Com because such a modification would allow Yaksich to have the information that is entered

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to become part of the database for that item (the item could be a corporate logo).

With respect to claim 28. Yaksich failed to disclose, The system of claim 17, wherein the print processing facility generates a print production request to produce the printed product without any human intervention at the corporate facility and without any human intervention at the print production facility. Sevcik discloses, The system of claim 17, wherein the print processing facility generates a print production request to produce the printed product without any human intervention at the corporate facility and without any human intervention at the print production facility (col. 9, lines 26-64). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yaksich with the teachings of Sevcik because such a modification would allow Yaksich to have a system with a home page that includes all of the information that a print buyer needs in order to send a print production job over the Internet from a corporate facility to a print production facility.

With respect to claim 29. Yaksich discloses, The system of claim 17, wherein the print processing facility translates at least some of the event data into a common print production request based on a schema mapping between fields in the corporate human resources database and fields stored in the print processing facility (col. 11, lines 30-39 and col. 13, line 1-col. 16, line 55)

With respect to claim 30, Yaksich failed to disclose, The system of claim 17, wherein the printed product comprises a sales brochure. Sevcik discloses, The system of claim 17, wherein the printed product comprises a sales brochure (col. 7, lines 3-12). It would have been obvious to one having ordinary skill in the art at the time the invention was

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made to modify in Yaksich with the teachings of Sevcik because such a modification would allow Yaksich to have what is known as marketing collateral which includes sales and data sheets and brochures (sales literature.

Response to Arguments

Applicant's arguments filed 02/04/09 have been fully considered but they are not persuasive.

Issue no. 1: Applicants' argue: Sevcik fails to overcome the deficiency of Yaksich and Sevcik does not teach or suggest that the printing processing facility "compares the event data to one or more predefined event rules that determine whether the printed product should be produced ...". Sevcik specifically teaches away from the feature of claim 17 has been considered but is not persuasive. Response: If the buyer does not determine whether the event data to one or more pre-defined event rules that the printed product should be produced, it is unclear how the print facility according to the claim limitations make this determination.

The usage of the term "whether" makes the claim limitation indefinite and does not distinguish the claim from the prior art. See *In re Collier*, 158 USPQ266 (CCPA 1968).

"An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed ...". *In re Zletz* 13 USPQ2d 1320 (Fed. Cir. 1989).

Issue no. 2: Applicants' argue: Sevcik specifically teaches away from the feature in issue no. 1 above for claim 17 has been considered but is not persuasive. Response:

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"A reference is no less anticipatory, if, after disclosing the invention the reference discharges it. Thus, the question whether a reference teaches away from the invention is inapplicable to an anticipation analysis." *Celeritas Techs.Ltd. v. Rockwell Int'l Corp.*, 47 USPQ 2d 1516 (Fed. Cir. 1998).

"The test of obviousness is not whether features of secondary reference may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested in any one or all of the references; rather, the test is what the combined teachings of references would have suggested to those of ordinary skill in the art". *In re Keller*, 208 USPQ 871 (CCPA 1981).

Issue no. 3: Applicants' argue: Sevcik does not teach or suggest the claim 17 feature of "in response to a positive determination, automatically generates a print order for the printed product using information extracted from the event data" has been considered but is not persuasive. Response: It is unclear and vague what Applicants' mean by "in response to a positive determination". Do Applicants' mean "in response to a positive determination the printed product should be produced" or "in response to a positive determination the print order is generated"?

Sevcik discloses in col. 6, line 64-col. 7, line 2 what is interpreted as "in response to a positive determination, automatically generates a print order for the printed product using information extracted from the event data". These col. and line numbers recite "a press check option which allows the print buyer to approve the project when it is on the press prior to having the entire project printed. If the print buyer wants a press check,

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then the system also prompts the buyer for the maximum distance the buyer is willing to travel for the press check".

Issue no. 4: Applicants' argue: IPrint.com fails to cure the deficiencies of Sevcik and Yaksich and fails to teach or suggest the features of claim 17 has been considered but is not persuasive. Response: IPrint.com was not used to reject any of the claim limitations of claim 17. Sevcik and Yaksich were used to reject the claim limitations of claim 17.

In an effort to move the Application to an Allowance it is respectfully requested that Applicants' clarify the issues raised in the claim limitations.

"However, this court has consistently taken the tack that claims yet unpatented are to be given the broadest reasonable interpretation consistent with the specification during the examination of a patent application since the applicant may then amend his claims, the thought being to reduce the possibility that, after the patent is granted, the claims may be interpreted as giving broader coverage than is justified." *In re Prater*, 162 USPQ 541 (CCPA 1969).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dixon Thomas can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/
Primary Examiner, Art Unit 3696

April 20, 2009